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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/633,295	08/07/00	NICHTL	A 100564-00025

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EXAMINER

DO,P

ART UNIT	PAPER NUMBER
1641	<i>S</i>

DATE MAILED: 12/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/633,295

Applicant(s)

Alfons Nichtl

Examiner

Pensee T. Do

Group Art Unit

1641



☒ Responsive to communication(s) filed on Aug 7, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-23 is/are pending in the application

Of the above, claim(s) 1-16 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 17-23 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Miscellaneous

1. The preliminary amendment filed on August 7, 2000 has been acknowledged.
2. Claim 22 depends on canceled claims 1-11.

Election/Restriction

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 17-21, drawn to a method for the stabilization of conjugates composed of colloidal particles and biomolecules, classified in class 436, subclass 523.
 - II. Claim 22, drawn to a test kit, classified in class 435, subclass 975.
 - III. Claim 23, drawn to a method for producing colloidal particles on the surface of which molecules are absorbed, classified in class 436, subclass 525.

4. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MEP. § 806.05(h)). In the instant case the test kit of invention II can be practiced using a different process such as adding a

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detergent to wash the unbound biomolecules. The relationship of invention II and invention III are the same as that of inventions II and I.

5. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MEP. § 806.04, MEP. § 808.01). In the instant case the different inventions are unrelated because the method of invention I is used for stabilizing conjugates comprising of colloidal particles and the method of invention II is a process for producing colloidal particles. Both inventions have different effects (e.g. one is stabilizing the conjugates of biomolecules and colloidal particles and the other is producing colloidal particles), modes of operation (e.g. invention one does not have the steps of adding biomolecules to the colloidal particles).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pensee T. Do whose telephone number is (703) 308-4398.

Christopher L. Chin

CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800-1641

Pensee T. Do
Patent Examiner
December 19, 2000